

REMARKS

This communication is a full and timely response to the non-final Office Action dated June 29, 2006. By this communication, claims 2, 10, and 15 have been cancelled without prejudice or disclaimer to the underlying subject matter, claims 1, 9, and 14, have been amended, and claims 19-21 have been added. Support for the subject matter added to claims 1, 9, and 14 and new claims 19-21 can be found, for example, in original claims 2, 10, and 15, respectively. Claims 1, 3-9, 11-13, and 16-21 are pending.

Rejections Under 35 U.S.C. §§102 and 103

Claims 1, 3-9, 11-14, and 16-18 were rejected under 35 U.S.C. §102(e) as anticipated by *Saito et al.* (U.S. Patent No. 6,208,426); and claims 2, 10, and 15 were rejected under 35 U.S.C. §103(a) as unpatentable over the *Saito* patent in view of *Toyoda* (U.S. Patent No. 6,441,916). Applicant respectfully traverses these rejections.

As a preliminary matter, because independent claims 1, 9, and 14 have been amended to include subject matter that the Office Action acknowledges is neither taught or suggested by the *Saito* patent, the rejection of these claims and their associated depending claims is rendered moot. Accordingly, Applicant requests that the rejection under 35 U.S.C. §102 be withdrawn.

Secondly, Applicant submits that the subject matter previously recited in claims 2, 10, and 15, and now incorporated into claims 1, 9, and 14, respectively, is allowable over the combination of the *Saito* patent and the *Toyoda* patent. Specifically, the subject matter cited in claims 1, 9, and 14 is directed to a feature that enables a data transmission apparatus to send data to a recipient in a first email

and when a recognition unit recognizes that transmission errors are associated with the first email, an email transmission unit sends a tool program to the recipient in a second email.

The Office Action acknowledges that the *Saito* patent fails to teach a recognition unit as recited in the claims, and relies on the *Toyoda* patent to remedy this deficiency. Applicant submits, however, that both the *Saito* patent and *Toyoda* patent fail to teach or suggest the combination of sending data in a first email and sending a tool program in a second email when an error is detected with respect to the first email, as recited in the claims.

The *Saito* patent teaches sending a URL link or HyperText link in an email so that the recipient can access data across a network such as the Internet. The *Toyoda* patent teaches an error detection technique associated with a sent email, however, there is no evidence that a second email is sent to the same recipient when the error in association with the first email is detected. In fact, the *Toyoda* patent teaches that a reply message, which indicates the occurrence of an error, is returned to the sender (col. 4, lines 35-52). Neither the *Saito* patent nor the *Toyoda* patent teach or suggest that a URL link is sent to a recipient in an email when an error is detected in a previous email. At best, the combined references arguably teach that when an error is detected in an email that is transmitted to a recipient, a reply message identifying the error is returned to the sender. For at least these reasons, a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by

combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least these reasons, Applicant requests that the rejection under 35 U.S.C. §103 be withdrawn, and independent claims 1, 9, and 14 and their associated depending claims be allowed.

Newly added claims 19-21 depend from claims 1, 9, and 14, respectively. For at least this reason, Applicant submits that claims 19-21 are also allowable. Applicant believes that claims 19-21 are further distinguishable over the prior art of record by the additional elements recited therein. Accordingly, Applicant requests that claims 19-21 be considered and allowed.

Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1, 3-9, 11-14, and 16-21 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicant requests that the Examiner contact the undersigned attorney at the number below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: September 13, 2006

By: Shawn B. Cage
Shawn B. Cage
Registration No. 51,522

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620